

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|------------------|---|-----------------------------------|
| Application No. | : | 10/688,261 |
| Applicant | : | Norbert Hahn |
| Confirmation No. | : | 4594 |
| Filed | : | October 17, 2003 |
| TC/A.U. | : | 3721 |
| Examiner | : | Weeks, Gloria R. |
| Customer No. | : | 28268 |
| Docket No. | : | P-US-PR-1088 |
| Title | : | TOOL HOLDER FOR IMPACTING MACHINE |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Sir:

In response to the Office Action filed on November 24, 2009, please reconsider the above-identified application in view of the following Amendments and Remarks:

Remarks begin on page 2 of this paper.

REMARKS

Claims 1, 3-7, 9, 10, 12-25 and 33 are pending in this application. Claims 1, 3-7, 9, 10, 12-25 and 33 stand rejected. Claims 2, 8, 11, and 26-32 have been cancelled.

Claims 1, 5, 9, 16, and 19 are rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 4,830,549 to Neumaier et al. (“*Neumaier*”). Claims 1, 3, 4, 6, 7, 9, 10, 12-15, 17, 18, 20-25, and 33 are rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,601,388 to Lauterwald (“*Lauterwald*”), in view of U.S. Patent No. 5,403,132 to Truesdell (“*Truesdell*”).

Claims 1, 2, 5, 9, 16, and 19 are rejected under 35 U.S.C. §102(b), as being anticipated by *Neumaier*. This rejection is respectfully traversed.

Initially, Applicant would like express appreciation to Examiner Weeks for taking the time to enhance her interpretation of the claims with supplemental drawings. In general and when appropriate, such marked drawings tend to save Applicant time and reduce Applicant’s costs by minimizing confusion.

Independent claim 1 recites that “the manually actuatable sleeve is axially slideably mounted along the main body” as originally recited in dependent claim 2. *Neumaier* fails to teach this and other features.

Neumaier fails to teach a sleeve that is axially slideable along the main body. In contrast, *Neumaier* teaches an actuating collar 18 that encircles the actuating sleeve 17 and is accessible on the exterior of the drill for rotating the actuating sleeve (col. 4, lns. 61-66). Furthermore, *Neumaier* teaches that “[t]o remove the working tool 5 from the holder 1, the actuating sleeve 17 is turned around the axis of the holder in a limited extent by means of the actuating collar 18” (col. 6, lns. 23-25). In other words, as far as Applicant can determine from the *Neumaier* patent, *Neumaier* discloses a sleeve rotation feature and not an axial translation feature as claimed in claim 1.

In the Response to Arguments of November 24, 2009, the Examiner argues that she “has found” that parts assembly would required the claimed axial sliding. Applicant asserts that such a reading of *Neumaier* could only be purely speculative. For example, *Neumaier*’s actuating collar 18 could be assembled in halves that snap together without the claimed axial movement. The Examiner’s guess regarding the manner in which *Neumaier* is assembled is as good as Applicant’s and just as irrelevant as Applicant’s because *Neumaier* disclosed neither guess.

Neumaier therefore does not teach each feature of claim 1. Claim 1 is believed to include allowable subject matter. The Examiner is respectfully requested to withdraw the rejection of claim 1. Claims 5, 9, 16, and 19 depend from claim 1 and are therefore also include the allowable subject matter of claim 1. The Examiner is also respectfully requested to withdraw the rejection of claims 5, 9, 16, and 19.

Claims 1-4, 6, 7, 9, 10, 12-15, 17, 18, 20-25, and 33 are rejected under 35 U.S.C. §103(a), as being unpatentable over *Lauterwald*, in view of *Truesdell*. This rejection is respectfully traversed.

Claims 1 and 33 require “an elongated locking element pivotably mounted at a pivot point on an exterior surface of the main body, the locking element including ... an engaging portion ... the engaging portion pivotably movable between ... a lock position ... and a unlock position”. Neither *Lauterwald*, *Truesdell*, nor their combination teach each of the above features. In other words, the claimed invention recites a pivotable locking element. The locking element also more specifically includes an engagement portion and the engaging portion is pivotable and engageable with the retaining collar of the tool. These claim features will be taken in turn below.

First, the elongated locking element is pivotable. The Office Action relies on *Lauterwald* for an elongated locking element and defines the locking element as being the combination of locking body 50 and protection cap 60. The Examiner is forced to unreasonably stretching the disclosure of *Lauterwald* because the claim requires the locking element to pivot as well as to engage the retaining collar of the tool. No single *Lauterwald* element accomplishes both features. As a result of the Examiner’s definition, a portion (50) of *Lauterwald*’s locking element (50, 60) never pivots even though claim 1 requires the locking member to be an “element pivotably mounted”. Furthermore, the remaining portion of the of *Lauterwald*’s locking element (50, 60) does not engage the retaining collar of the tool except indirectly through locking body 50.

Second, claim 1 requires that the engaging portion is pivotably moveable and the engaging portion is engageable with the retaining collar. In other words, the engaging portion is the specific portion of the locking element that engages the retaining collar and that is pivotably moveable. In contrast, *Lauterwald*’s engaging portion 62 never engages the retaining collar. Again, because the engaging portion is a specific portion of the locking element capable of engaging and pivoting, the examiner chooses *Lauterwald*’s elastically deformable rear end cap 62 as the engaging portion. However, the result

of the Examiner's unreasonable interpretation is that the portion (locking body 50) of *Lauterwald's* locking element (50, 60) that really engages the retaining collar is not pivotable as required by claims 1 and 33. In addition, the portion that pivots (elastically deformable rear end cap 62) never engages the retaining collar.

In fact, *Lauterwald* teaches away from the claimed invention. The Examiner is defining a locking element (50, 60) which includes a portion (locking body 50) that actually engages the retaining collar of the tool. However, because that portion (locking body 50) does not pivot, the Examiner interprets (elastically deformable rear end cap 62) to be the engaging member. However, the engaging member does not engage the retaining collar as required by claims 1 and 33. Because the portion (locking body 50) of *Lauterwald's* locking element (50, 60) that actually engages the retaining collar is designed not to pivot as required by claims 1 and 33, *Lauterwald* teaches away from the claimed invention.

Truesdell does not remedy *Lauterwald's* deficiencies with respect to claims 1 and 33. *Truesdell* is cited for an engagement portion positioned between the forward end of the main body and the pivot point. The Examiner asserts that it would have been obvious to modify *Lauterwald* to include the deficient feature "since *Truesdell* teaches that such a modification would also result in clamping of a main body and tool within the locking element, and the selection of any of these known equivalents to secure a tool within the machine would be within the level of ordinary skill in the art."

As best as Applicant can understand the Examiner's justification for combining the cited references is that, since *Truesdell* teaches a tool holder with a forward extending flexible holding element it can be combined with *Lauterwald* because they are both equivalents, as they are both tool holders. However, the Examiner's burden is not merely to find a substitute for *Lauterwald's* tool holder, and thereafter, any element of *Truesdell's* tool holder is justifiably combinable with *Lauterwald*. The Examiner's burden is to justify why one of ordinary skill would find it obvious to substitute the specific deficient feature (i.e., an engagement portion positioned between the forward end of the main body and the pivot point) into the already existing features of *Lauterwald's* tool holder which works completely differently. For example, *Truesdell* teaches a tool holder that secures a tool by a rotational actuator that generates a friction fit. On the other hand, *Lauterwald* teaches a tool holder that secures a tool by an axially moving actuator which extends a protrusion into a recess of a tool. In other words, even for

argument sake, if it can be said that both references teach tool holders that facilitate the same result (i.e., secure a tool), it cannot be said that because of this shared result, any feature from one reference can be properly and obviously integrated into the other.

Lauterwald cannot be simply reversed. The tool is not symmetric, yet a key element must be “reversed” while still allowing the tool to operate and be inserted from its original direction. Such a reversal would require a non-obvious redesign the implementation of which would not be obvious to Applicant. Applicant argues that the required redesign would also not be obvious to one of ordinary skill. Furthermore, the Examiner has not made an effort to explain how this reversal would be implemented. Therefore, it would not be obvious to modify *Lauterwald* with *Truesdell* as suggested by the Examiner.

Claims 1 and 33 are therefore believed to include unique allowable subject matter. In addition claims 3, 4, 6, 7, 9, 10, 12-15, 17, 18, 20-25 depend from claim 1 and therefore also include unique subject matter. The Examiner is therefore requested to withdraw the rejection of claims 1, 3, 4, 6, 7, 9, 10, 12-15, 17, 18, 20-25, and 33.

In view of the foregoing, Applicant respectfully requests the Examiner to find the application to be in condition for allowance with claims 1, 3-7, 9, 10, 12-25 and 33. However, if for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney to discuss any unresolved issues and to expedite the disposition of the application.

A Notice of Appeal is submitted herewith including the \$540.00 fee under 37CFR 41.20(b)(1). In addition, the Commissioner is hereby authorized to charge payment of any additional fees required for the above-identified application or credit any overpayment to Deposit Account No. 02-2548.

Dated: February 23, 2010

Respectfully submitted by:

BLACK & DECKER CORPORATION
CUSTOMER NO. 28268
701 East Joppa Road, TW199
Towson, MD 21286
(410) 716-2881

/Kofi A. Schulterbrandt/
Kofi A. Schulterbrandt
Reg. No. 50,168